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22879 7590 09/04/2009 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528			EXAMINER PROCTOR, JASON SCOTT	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VASANTH BALA, PAOLO FARABOSCHI,
and GIUSEPPE DESOLI

Appeal 2009-002101
Application 09/874,170¹
Technology Center 2100

Decided: September 3, 2009

Before JOSEPH L. DIXON, ST. JOHN COURTENAY, III., and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed June 4, 2001. The real party in interest is Hewlett-Packard Development Company.

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 2-24 mailed October 10, 2007, which are all the claims remaining in the application, as claim 1 is cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

A. INVENTION

Appellants invented a system, method, and computer program product for providing a client-server architecture wherein an application resides on a server, and portions of the application are transformed by the server into a native code executable by a client, and transmitted to, cached in, and executed by the client. (Spec. 1:6-9.)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 2-24. Claims 2, 9, 14, 18, and 23 are independent claims. Claim 2 is illustrative:

2. A networked system comprising:
a network;
a server coupled to the network, wherein the server includes:
an application code source that stores a client application; and a server code manager coupled to the application code source;
an application code transformation manager coupled to the application code source, for transforming the client

application from a first format to a native binary format compatible with a native instruction set of the CPU of the client; and

a server code segment manager coupled to the application code transformation manager, for parsing the client application in the native binary format into a plurality of code segments, said parsing of said code segments being dynamically performed based on actual server-side and client-side execution overhead, network bandwidth efficiency and client-side storage requirements on a per client basis, and configured based on predicted code segment usage or prior code segment usage history, at least one of said plurality of code segments being transmitted to the client via the network; and

a client coupled to the network said client not having said client application stored thereon, wherein the client comprises:

a CPU for natively executing at least one of said plurality of said code segments derived from the client application stored on said server;

a code cache coupled to the CPU, for storing said code segments; and a client code manager coupled to the code cache for launching the client application by requesting that the server code manager transmit at least one of the plurality of dynamically tailored code segments to the client, receiving at least one of the dynamically tailored code segment from the sever, storing the dynamically tailored code segments in the code cache, and executing at least one of the plurality of dynamically tailored code segments using the CPU until the executed dynamically tailored code segment attempts to pass control to a required code segment not stored in the code cache, at which point control passes back to the client code manager to retrieve the required code segment from the server, with the CPU continuing execution with the required code segment.

C. REFERENCE

The sole reference relied upon by the Examiner as evidence in rejecting the claims on appeal is as follows:

Shimura

US 6,370,687 B1

Apr. 9, 2002
(Filed Nov. 16, 1999)

D. REJECTION

The Examiner entered the following rejection which is before us for review:

Claims 2-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimura in view of Official Notice.

II. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Shimura

1. Shimura discloses that “in response to a request for the JAVA program from a client to the Web server on the network, the substitute compile server 10 returns to the client the Java program which has been compiled and optimized into a native code conforming to the execute form of the requester client.” (Col. 6, ll. 25-30.)

III. PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants' Brief to show error in the proffered *prima facie* case. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief has not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

IV. ANALYSIS

The Obviousness Rejection

We now consider the Examiner's rejection of the claims under 35 U.S.C. § 103(a).

Appellants contend that "[t]here is no mention of 'parsing the client application in the native binary format into a plurality of code segments' as is provided in the features of Appellants' Claim 2. In fact, Shimura remains silent as to parsing or dividing a client application into a plurality of code segments." (Reply Br. 5.)

The Examiner found that “[p]arsing” is a necessary and inherent step to compile application code such as Java code and there appears to be no argument that generic ‘parsing’ is disclosed in Shimura.” (Ans. 10.)

Issue: Have Appellants shown that the Examiner erred in finding that Shimura discloses “parsing the client application in the native binary format into a plurality of code segments,” as set forth in claim 2?

The Examiner seems to suggest (e.g., Ans. 9-10) that the “parsing” limitation of claim 2 is inherent in Shimura’s “compiling” step. While one of ordinary skill in the art may recognize that “compiling” inherently includes a “parsing” function, we agree with Appellants that claim 2 requires more than mere parsing of code. For example, claim 2 requires, *inter alia*, that the client application be parsed “into a plurality of code segments” and the “plurality of code segments being transmitted to the client.” In other words, the claimed invention requires the use of “code segments.” While Shimura discloses returning to the client a Java program which has been compiled (i.e., parsed) and optimized into a native code (FF 1), we do not find any clear indication that Shimura’s “compiling feature” operates an inherent parsing function in a fashion analogous to that required by claim 2, e.g., so as to provide separate pieces of the program, i.e., “code segments.” Furthermore, while Shimura discloses returning the Java program to the client, the Examiner has not shown that Shimura’s program is returned as “code segments” to the client, a required feature of claim 2. As such, we can only rule on the basis of the evidence that is provided in support of the

rejection, and we find it deficient in this case. The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. § 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Here, the Examiner has not shown and we do not find where Shimura discloses using/transmitting “code segments.”

Given that the Examiner has not established that Shimura discloses “code segments” as recited in claim 2, we conclude that Appellants have shown error in the Examiner’s rejection of claim 2. Because independent claims 9, 14, 18, and 23 all contain similar “code segments” limitations to those of claim 2 that we have discussed, and are rejected on the same basis as claim 2, we also cannot sustain the rejection of remaining independent claims 9, 14, 18, and 23.

Since we agree with at least one of the arguments advanced by Appellants, we need not reach the merits of Appellants’ other arguments. It follows that Appellants have shown that the Examiner erred in finding that Shimura in view of Official Notice renders claims 2-24 unpatentable. Therefore, we reverse the Examiner’s § 103 rejection of independent claims 2, 9, 14, 18, and their respective dependent claims.

V. CONCLUSIONS

We conclude that Appellants have shown that the Examiner erred in rejecting claims 2-24.

VI. DECISION

In view of the foregoing discussion, we reverse the Examiner's rejection of claims 2-24.

REVERSED

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